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OFFICE OF PETITIONS

In re Application of
Beight, et al. :
Application No. 10/629,817 :
Filed: July 29, 2003 :
Attorney Docket No. X11792B :
For: AROMATIC AMIDES :

ON PETITION

This is a decision on the petition filed July 21, 2005 (certificate of mailing date July 19, 2005), requesting, in effect, that the Notice of Omitted Item(s) in a Nonprovisional Application (Notice), mailed May 20, 2005, be withdrawn. The petition will be treated under 37 CFR 1.53(e).

The application was filed on July 29, 2003. However, on May 20, 2005, the Office of Initial Patent Examination mailed a Notice stating that the application had been accorded a filing date of July 29, 2003, and advising applicants that pages 382-387 of the specification, appeared to have been omitted.

In response, the present petition was filed. The petition does not allege and is not accompanied by any evidence that pages of specification numbered 382-387 were present in the Office on July 29, 2003. In fact, petitioners state that they apparently were inadvertently omitted.

The transmittal letter states that 388 pages of specification were filed on July 29, 2003, but only 382 are present in the application file - - pages 1-381 and an abstract on a separate page. Therefore, the Notice mailed May 20, 2005, was correct in advising applicants that pages 382-387 appeared to have been omitted. The Notice was properly mailed and will not be withdrawn. The petition fee is required, since the petition was not necessary to correct any PTO error.

Petitioners request that the claims found on pages 382-387 be deemed as timely deposited as of the time of filing of the divisional application. This request cannot be granted at present time. The claims were not filed on July 29, 2003 on pages 382 - 387. It is noted that they appear to be present in amended format in the Preliminary Amendment, filed on July 29, 2003.

If petitioners desire to add pages 382-387 from application No. PCT/US99/29946, petitioners have another option. Application no. PCT/US99/29946 was incorporated by reference into the present

application when it was filed.

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter.... The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition.... (emphasis supplied)

If applicants desire that the omitted pages of specification from application no. PCT/US99/29946 be added to the application, the appropriate procedure is by way of amendment. Any such amendment should be filed prior to the first action on the merits and will be considered by the examiner.

The application is being returned the Office of Initial Patent Examination for further processing with a filing date of July 29, 2003. Pages 382-387 filed with the instant petition will not be processed as part of the application papers.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.


E. Shirene Willis
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy